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| EXAMINER | |
|---|---|
| KLIMOWICZ, WILLIAM JOSEPH | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2652 | |

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/018,143 | LIEDTKE ET AL. | |
| | Examiner | Art Unit | |
| | William J. Klimowicz | 2652 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *09 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *37-69* is/are pending in the application.

4a) Of the above claim(s) *54-69* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *37-48 and 50-53* is/are rejected.

7)☒ Claim(s) *49* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 April 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

Applicants' election with traverse of the Lack of Unity of invention in Paper No. 9 is acknowledged. The traversal is on the ground(s) that a "common element to all claims is the presence of a transparent adhesive film." Thus, in the opinion of the Applicants, the claims do not lack unity of invention.

This is not found persuasive because the Examiner maintains that as previously set forth in the Restriction requirement (Paper No. 8 and repeated again in Paper No. 11, mailed September 12, 2003 and December 3, 2003, respectively), that there exists three distinct and separate Groups based on a lack of unity. More concretely, Group I, was identified as claim(s) 37-53, drawn to a method of coating an optically readable data carrier. Group II, was identified as claim(s) 54-64, drawn to an apparatus for coating an optically readable data carrier. Group III, was identified as claim(s) 65-69, drawn to an optically readable data carrier.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group II includes the special technical feature of a laminating station, with, *inter alia*, an aligning unit, pressure rollers, etc. not set forth in either of Groups I or II, which is classified in Class 1569/584 and/or Class 156/538 of the US Patent Classification System, and in which Groups I or III are not.

Group I includes the special technical feature of, *inter alia*, withdrawing a protective film from an adhesive film prior to application of the adhesive film on a carrier surface, etc., which is classified in Class 156/238 or 156/250 of the US Patent Classification System, and in which Groups II or III are not.

Group III includes the special technical feature which sets forth a particular special technical feature of, *inter alia*, a protective housing which houses a positively claimed data carrier, etc., which is classified in Class 369/291 of the US Patent Classification System, and in which Groups I or II are not.

Additionally, it is noted that the Applicants did not traverse on the ground that the three Groupings of claims are not patentably distinct. If the Applicants were to traverse on the ground that the three claim Groupings I-III ***are not patentably distinct***, the Applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. If the ***Applicants were to include such a statement, the election requirement would be withdrawn***. In either instance, however, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

The requirement is still deemed proper and is therefore made FINAL.

Claims 54-69 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 12

This application contains claims 54-69 drawn to an invention nonelected with traverse in Paper No. 12. A **complete reply** to the final rejection ***must*** include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 52, the phrase "wherein a transparent protective layer, especially a PC tape, is applied to a non-adhesive side of said adhesive film" is vague and ambiguous. More concretely, it cannot be readily ascertained as to whether the phrase "especially a PC tape" is a positive limitation as it applies to the claim. That is, does the claim require the PC tape?

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 37-47, 50, 51 and 53 are rejected under 35 U.S.C. 102(e) as being anticipated by Amo (US 6,200,402 B1).

As per claim 37, Amo (US 6,200,402 B1) discloses a method of coating an optically readable data carrier (e.g., D1), including the step of: applying a transparent adhesive film (e.g. S2 - polyethylene - COL. 6, line 34) to a data carrier surface (surface of D1) that is to be protected, wherein said adhesive film (S2) is provided with adhesive on one side (e.g. side opposite release layer (S3)).

As per claim 38, which includes the step of withdrawing said adhesive film from a carrier film (e.g., S1) during or after application of said adhesive film (S2) to said data carrier (D1) surface (e.g., see, *inter alia*, COL. 11, lines 8-19).

As per claim 39, which includes the step of withdrawing a protective film (e.g. S3) from said adhesive film (S2) prior to application of said adhesive film (S2) to said data carrier (D1) surface (e.g., see, *inter alia*, COL. 7, line 44 through COL. 8, line 20 and FIG. 1).

As per claim 40, wherein a shape and size of said adhesive film (S2) corresponds to said data carrier (D1) surface (e.g., see, *inter alia*, FIG. 15B).

As per claim 41, wherein sections of said adhesive film that correspond to a shape and size of said data carrier surface are punched onto a carrier film (S1) (via punch (3)).

As per claim 42, wherein said adhesive film (S2) is applied to said data carrier (D1) surface in a centered manner (e.g., see, *inter alia*, FIG. 15B).

As per claim 43, wherein said adhesive film (S2) and said data carrier (D1) surface are aligned with one another prior to said applying step (see, *inter alia*, cf. FIGS. 2 and 3).

As per claim 44, wherein during said applying step said adhesive film (S2) is pressed against said data carrier (D1) surface via a rotating pressure roller (1).

As per claim 45, which includes the step of controlling a pressure of said pressure roller (e.g., the member (1) is controlled is some manner to apply a pressure by being moved vertically downward to engage the sheet (S), and is then controlled so as to move laterally across squeezing out air bubbles trapped in the adhesive film).

As per claim 46, wherein prior to being pressed by said pressure roller (1), said adhesive film (S2) is held at a pre-specified angle relative to said data carrier (D1) surface (e.g., see, *inter alia*, COL. 9, lines 45-50).

As per claim 47, wherein said pressure roller (1) and said data carrier (D1) surface are moved relative to one another (cf. FIGS. 4-7).

As per claim 50, wherein said adhesive film (S2) is a layer of adhesive material without carrier material (S1) (e.g., after it is processed).

As per claim 51, wherein said adhesive film (S2) is hardened via at least one of pressure, time, UV radiation and thermal treatment (e.g., see, *inter alia*, FIGS. 17 and 18).

As per claim 53, wherein said adhesive film (S2) is an adhesive film (S2) that responds to pressure, and wherein the adhesion characteristics of said adhesive film (S2) vary as a function of pressure (via press (100)).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Amo (US 6,200,402 B1).

See the description of Amo (US 6,200,402 B1), *supra*.

As per claim 48, although Amo (US 6,200,402 B1) does not expressly disclose wherein said data carrier (D1) surface is moved "linearly" past said pressure roller (1) (the data carrier surface is moved on a rotary table (2)), Official notice is taken that linearly moved disc processing stations (as per claim 48), are notoriously old and well known and ubiquitous in the art; such Officially noticed fact being capable of instant and unquestionable demonstration as being well-known.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a linearly moving station in lieu of a rotary table of Amo (US 6,200,402 B1).

The rationale is as follows: one of ordinary skill in the art would have been motivated to provide a linearly moving station in lieu of a rotary table of Amo (US 6,200,402 B1) in order to provide a readily accessed sequential station assembly, which allows progression in a straight path, thus facilitating the changeover in station assemblies if one should malfunction, as is known in the art. No new or unobvious result is seen to be obtained by exchanging a rotary platform station with a linear platform station; both station types being readily known in the art.

### *Allowable Subject Matter*

Claim 49 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (703) 305-3452. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William J. Klimowicz

Primary Examiner
Art Unit 2652

WJK